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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/817,051

04/02/2004

Gary P. Goodfried

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07/09/2008

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EXAMINER

RAMANA, ANURADHA

ART UNIT

PAPER NUMBER

3733

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/817,051	<b>Applicant(s)</b> GOODFRIED ET AL.	
	<b>Examiner</b> Anu Ramana	<b>Art Unit</b> 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 April 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-9 and 24-34 is/are pending in the application.
- 4a) Of the above claim(s) 3-4, 8-9 and 26-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6, 7, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/6/07 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2 and 6-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, the limitation, "distance from the articulating surface to the end" renders the claim vague and indefinite since it is unclear what reference point on the articulating surface is being used to measure the distance.

In claim 6, the limitation, "the distance from the distal articulating surface to the proximal end" renders the claim vague and indefinite since it is unclear what reference point on the articulating surface is being used to measure the distance.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by O'Neil et al. (US 6,071,311).

O'Neil et al. disclose a modular orthopedic implant system including: a first component 18 having a tapered bore 46 or 46', an articulating surface and an end opposite the articulating surface, wherein the maximum dimension of the first component in one direction is the distance from the articulating surface to the end; a tapered metaphyseal component (14, 16 and 20) including a tapered post 70; and a

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distal femoral component 12 (Figs. 1, 3, 4, 7A-7B and 8B, col. 2, lines 60-67, cols. 3-6 and col. 7, lines 1-5). It is noted that tapered post 70 is sized and shaped to be received in bore 46' of first component 18.

Using an alternate interpretation, claims 6-7, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by O'Neil et al. (US 6,071,311).

O'Neil et al. disclose a modular orthopedic implant system including: a first component 18 having a tapered bore 46 or 46' , an articulating surface and an end opposite the articulating surface, wherein the maximum dimension of the first component in one direction is the distance from the articulating surface to the end; a tapered metaphyseal component or second implantable component 14; an adapter (16 and 20) including two tapered posts 16 and 70 that are different from each other in size and shape (Figs. 1, 3, 4, 7A-7B and 8B, col. 2, lines 60-67, cols. 3-6 and col. 7, lines 1-5). It is noted that in an assembled configuration the two posts of the adapter are integral.

### ***Response to Arguments***

Applicant's arguments submitted under "REMARKS" in the response filed on April 4, 2008 have been fully considered.

Applicant's arguments with respect to O'Neil et al. are not persuasive for the following reasons. O'Neil et al. clearly disclose all elements of Applicant's claimed invention as discussed in this office action. The Examiner notes that the bore of O'Neil et al. is located at an end or extremity of the first component in one direction. The recited "one direction" could be any given direction since no reference axis or points are defined to fix the "one direction."

Regarding the limitation, "most narrow at the ends of the adapter," post 16 is narrow at one end while post 70 is narrow (70B) at one end (defined by head 72 of the bolt). It is further noted that the term "integral" is sufficiently broad to embrace

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constructions united by such means as fastening and welding. *In re Hotte*, 177 USPQ 396, 328 (CCPA 1973).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR  
July 7, 2008

/Anu Ramana/  
Primary Examiner, Art Unit 3733